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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/643,002	08/18/2003	Mark Anthony Strom	314.001US1	2969

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EXAMINER
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SHAH, MILAP

ART UNIT	PAPER NUMBER
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3714

DATE MAILED: 11/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/643,002

Applicant(s)

STROM, MARK ANTHONY

Examiner

Milap Shah

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 August 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/21/04</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Drawings*

The drawings are objected to because of the reasons cited on the attached "Notice of Draftsperson Patent Drawing Review" form (PTO-948). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### *Specification*

The abstract of the disclosure is objected to because it appears to be exceeding the maximum of 150 words in length. Abstracts should be between 50-150 words in length. Correction is required. See MPEP § 608.01(b).

*Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 11 & 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Both claims 11 & 12, which depend from parent/base claims recite “a payline...” which is unclear as to if this is defining a different pay line that the “single payline” of the parent/base claims. Furthermore, the claims say “each frame”, which appears to be lacking antecedent basis, since “frame” has not yet been defined in the claims. The Examiner suggests rephrasing the claims to recite, “The method of claim 5, wherein the single payline comprises a number of frames, wherein each frame has a number of symbols available, excluding blank spaces, that is equal to the number of frames in the payline”. That recitation is for claim 11, however, “claim 5” of the recitation would be substituted for “claim 6” if used for claim 12 as well. It is also unclear if a frame is referring to a symbol position or a reel strip for the symbol position. For examination purposes, the examiner is interpreting “frame” as a symbol position, so that each symbol position on the symbol array is able to be one of five symbols if the total number of symbol positions are five. The Examiner requests clarification is this interpretation is not what the Applicant intended to recite.

*Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6, 14 & 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Walker et al. (U.S. Patent No. 6,068,552).

**Claims 1 & 14:** Walker et al. disclose the same invention of a method of playing a wagering game comprising:

- a) a player placing a wager in a wagering machine having a processor (abstract & figure 1[coin acceptor 124 & CPU 102]);
- b) the wagering machine randomly displaying at least a single pay line of symbols, the symbols having a predetermined indication of order (column 3, lines 34-39 & figure 8[pay schedule 229 indicates the payout based on order of symbols appearing]);
- c) the processor determining from displayed symbols on the pay line whether the symbols provide at least one of at least two available predetermined orders of symbols that are associated with an award (figure 11A[pay table 1100], note: the pay table shows specific awards per arrangement or sequence of symbols displayed and it clearly shows at least two predetermined orders, it is understood that the processor determines if the symbols shown match one of these predetermined orders to provide an award); and
- d) providing the player with an award when at least one of the at least two available predetermined orders are displayed on a pay line (figure 11A[pay table 1100], note: just like any slot machine, once a pay table is used to determine an award, the award is provided to the player in some manner).

Regarding claim 14, the “gaming apparatus” includes a housing, a processor, a symbol display area, and a user interface capacity as clearly seen in figures 1-12.

**Claims 2-6 & 15:** Walker et al. disclose a video poker embodiment (column 11, lines 20-49), in which it is understood that playing cards must be the indicia for a video poker game.

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Traditionally playing cards include both a rank and a suit, wherein the suit is considered the modifier that distinguishes like symbols into subsets of suits (i.e. 52 card deck has 13 cards each of 4 different suits, these 4 are considered the subsets). Regarding the latter part of claim 15, the pay table of a video poker embodiment, although not shown in Walker et al's figures, is traditionally considered to include a pay out for a straight flush, in which all the playing cards in a straight flush are in a particular predetermined order and have the same symbol modifier or suit.

*Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7-13 & 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al., as applied to claims 1-6, 14, & 15, where applicable.

**Claims 7-13:** Walker et al. disclose the invention substantially as claimed except for explicitly disclosing the following:

- a) the at least two predetermined orders of symbols are orders other than Royal Flushes with card symbols in ascending or descending order;
- b) each frame in the pay line having a number of frames has a number of symbols available, exclusive of blank spaces, that is equal to the number of frames in the pay line (claim 11), and the number of frames on the pay line is five, and the symbols available are selected from the group consisting of Aces, Kings, Queens, Jacks, & Tens.

Regardless of these deficiencies, they would have been an obvious matter of design choice to a game designer at the time of the invention. It is considered a mere design consideration as to which order of symbols or indicia are included in the pay table. Thus, excluding Royal Flushes as claims 7-10 discuss, would have been an obvious matter of design choice, as the desired gaming apparatus by one of ordinary skill (i.e. the game designer) would have been to exclude such combinations from the pay table. For the same reason, adjusting the reel strip to include only a certain number of different symbols as discussed in claim 11, further in claim 12, that is equal to the number of different symbol positions (or frames), is a matter of design choice. Neither one of these design choices appear to overcome any stated problem or are for any particular purpose other than aesthetics. See MPEP 2144.04 in which aesthetic design changes and *In re Seid*, 161 F.2d 229, 73 USPQ 431 are discussed. Through *In re Seid*, it has been found that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patently distinguish the claimed invention from the prior art. Therefore, it would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to modify Walker et al. to obtain the invention as specified in claims 7-13. Thus, regarding claim 13, the game designer is capable of implementing the specific claimed predetermined orders if they are desirable.

**Claim 16:** Walker et al. disclose the invention substantially as claimed including providing an outcome including five combined symbols via the video poker embodiment of their invention. The five symbols are considered order dependent for at least the reason of what is shown in figures 2 & 11A, which show the awards are dependent on order of the symbols. Walker et al. lack providing the symbols in two separate components in which the first component is a suit, that is not order dependent and a second component which is order dependent for use in determining awards via the pay table discussed above. However, it appears the first component,

which is considered the suit of card, has no impact on the award, thus, it can be seen that providing the combined symbol in this specific manner is merely for aesthetics. Walker et al. discloses the video poker embodiment in which playing cards having both a rank and a suit are to be displayed in the symbol positions, however, the mere aesthetic difference is that they are not displayed in two parts, but rather in one. Since the suit appears to have no functional or impact on the end result, it appears the invention would have worked the same in either delivery method in which the end result is five combined symbols or indicia of playing cards having a rank and a suit component. Thus, the specific delivery method discussed is considered an aesthetic change. See MPEP 2144.04 which discusses aesthetic changes (see also *In re Seid* as discussed above for claims 7-13). Therefore, it would have been prima facie obvious to one of ordinary skill in the art to perform aesthetic changes to the video poker embodiment of Walker et al. to obtain the invention as specified in claim 16. The various sections of Walker et al. are cited within claims 1-15, see the section regarding the video poker embodiment. Video poker is traditionally played as a five card draw poker game, thus five combined symbols are required.

**Claims 17-20:** In addition to the above discussion, aesthetic changes also provides for a generic description being the suit, and the species component being an A, K, Q, J, or T (i.e. the top 5 card ranks). See also explanation of claims 7-13, in which it was discussed that a game designer is capable of designing the game using only A, K, Q, J, & T and is capable of setting the predetermined orders to anything conceivable (i.e. 5 consecutive ranks of cards), if those particular symbols/indicia are desirable or if those particular predetermined orders are desirable for the gaming machine being designed, since both the symbol/indicia used and the predetermine order added to a pay table are obvious matters of design choice by the game designer.



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*Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

<u>Name</u>	<u>Reference</u>	<u>Applicability</u>
Yoseloff	U.S. Patent No. 6,227,969	Both discuss an award defined as a "positional win" which basis the award on the symbols/indicia comprising a predetermined order.
	U.S. Patent No. 6,386,973	
Rose	U.S. Patent No. 6,589,114	Has a second award which awards based on the same symbols from a first award, however, rearranged in a different order or sequence (abstract)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Milap Shah whose telephone number is (571) 272-1723. The examiner can normally be reached on M-F: 9:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hotaling can be reached on (571) 272-4437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



SCOTT JONES  
PRIMARY EXAMINER

M.B.S.